

Atty. Dkt. No. 039153-5002 (G0166)

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

No claims are requested to be cancelled. No claims are currently being amended. No claims are being added. No new matter is added.

This amendment does not add, change and/or delete claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 12-19 and 22-34 remain pending in this application.

On page 2 of the Office Action, claims 12-19, 22-25, 28-30 and 33-34 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,703,680 (Toyoshima). The Examiner states:

In re claim 12, Toyoshima discloses a fuse for an integrated circuit, the fuse comprising a material 11 capable of existing in a first phase (NiSi) or a second phase (NiSi<sub>2</sub>) in response to at least one of a current signal and voltage signal, the fuse having a different resistance in the first phase (20  $\mu\Omega\text{cm}$ ) than in the second phase (60  $\mu\Omega\text{cm}$ ) (col. 3, lines 15-56 and FIGS. 2A-B) . . . .

Applicant respectfully traverses the rejection.

On page 7 of the Office Action, claims 26-27 and 31-32 are rejected under 35 U.S.C. § 103 as being unpatentable over Toyoshima. The Examiner states:

In re claims 26-27, Toyoshima discloses a first sheet resistance that is several times the second sheet resistance (col. 3, lines 19-56) but does not explicitly disclose that the first sheet resistance is at least 8 times the second sheet resistance as recited in claim 27.

Atty. Dkt. No. 039153-5002 (G0166)

However, there is no evidence indicating the ranges of the first and second sheet resistance is critical and it has been held that it is not inventive to discover the optimum or workable range of a result-effective variable within given prior art conditions by routine experimentation. See MPEP § 2144.05. Note that the specification contains no disclosure of either the critical nature of the claimed dimensions of any unexpected results arising there from. Where patentability is aid to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

In re claims 31-32, Toyoshima does not explicitly disclose that the first phase has a sheet resistance between 1-5 ohms per square and the second phase has a sheet resistance between 10 and 40 ohms per square.

However, there is no evidence indicating the ranges of the sheet resistance of the first and second phase is critical and it has been held that it is not inventive to discover the optimum or workable range of a result-effective variable within given prior art conditions by routine experimentation. See MPEP § 2144.05. Note that the specification contains no disclosure of either the critical nature of the claimed dimensions of any unexpected results arising there from. Where patentability is aid to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919F2d. 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Applicant respectfully traverses the rejection.

Applicant respectfully submits that Toyoshima is not available as a prior art reference against the claims of the present application.

A Declaration by the inventor pursuant to 37 C.F.R. § 1.131 has been provided herewith, which provides evidence that the subject matter recited in Claims 12-19 and 22-34 was invented prior to the filing date of Toyoshima. According to the cover page of Toyoshima, Toyoshima was filed on December 31, 2001 as U.S. Patent Application No. 10/029,718 based on Japanese

Atty. Dkt. No. 039153-5002 (G0166)

Patent Application No. 2001-370245 filed on December 4, 2001. The Declaration establishes that the subject matter recited in Claims 12-19 and 22-34 was conceived at least by March 13, 2001. Exhibit A attached to the Declaration includes two invention disclosure forms that include drawings and statements establishing the invention of the subject matter recited in Claims 12-19 and 22-34 at least by March 13, 2001, which is before the December 31, 2001 filing date of Toyoshima.

Accordingly, the rejections of Claims 12-19 and 22-34 should be withdrawn because Toyoshima is not available as prior art under 37 C.F.R. § 102(e) against such claims. Reconsideration and withdrawal of the rejections of Claims 12-19 and 22-34 under 35 U.S.C. § 102(e) is therefore respectfully requested.

\* \* \* \* \*

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Atty. Dkt. No. 039153-5002 (G0166)

Respectfully submitted,

Date 9-22-05

By Joseph N. Ziebert

FOLEY & LARDNER LLP  
Customer Number: 34083  
Telephone: (414) 297-5768  
Facsimile: (414) 297-4900

Joseph N. Ziebert  
Attorney for Applicant  
Registration No. 35,421